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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/198,022	11/23/98	RHOADS G	4830-51475/W

LM31/1222

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EXAMINER	
TADAYON, B	
ART UNIT	**PAPER NUMBER**
2721	6

DATE MAILED: 12/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/198,022	RHOADS
Examiner	**Group Art Unit**
DR. B. TADAYON	2724 #6

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 10-27-99 (AMEND.).

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Final Action

1. Applicant's argument and amendment filed 10-27-99 were considered. Please see the following items:

Applicant argues that the reference does not teach: "steganographically encoding". However, examiner disagrees because encoding first data into second data inherently hides first data into second data. In addition, the degree of hiding , or degree of steganographically encoding, or degree of obviousness of encoding, is very subjective, and depends on the context, situation, and environment. In principal, there is no absoluteness in this concept of steganographically encoding. It is a relative term. That is, some data might be hiding from person A's eyes, and might be visible and clear to person B's eyes. Thus, applicant's usage of term "steganographically encoding" is very loose and broad, and have different meanings and degrees in different contexts, and for that reason, is not patentable. In addition, the reference has shown this element of hiding: See figure 2, and column 3 lines 15-25. This satisfies the language of steganographically encoding, completely. Thus, the rejection was proper.

2. Claim 10 is objected to because there are two periods at the end of claim 10.

3. The terminal disclaimer was submitted for one of the parent cases. However, the patent number for the second parent case was missing. The second patent number should also be added to the terminal disclaimer, as indicated below:

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-17, all pending claims, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5841886 (SN 08/763847, the parent case of the current application), and U.S. Patent No. 5850481 (SN 08/438159, the parent case of the current application). Although the conflicting claims are not identical, they are not patentably distinct from each other. For example, see claim number 1 of the parent cases, compared to claim 1 of the current case.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 8-13, 15-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nathans (PN 4972476; supplied by applicant; see previous office actions of the parent case).

Also, please see the reasons given in the previous office actions for parent cases, for example, see PN 5841886, SN 08/763847, one of the parent cases.

As to claims 1, 8, Nathans teaches these features (figure 2; figure 2; column 1 lines 40-45; figure 2; figures 2-4, column 3 lines 15-25; abstract).

As to claims 2-3, Nathans teaches these features (figure 2).

As to claims 4, Nathans teaches these features (figure 2, column 1 lines 29-40, column 1 lines 53-68, column 1 lines 5-19, column 2 lines 1-25, column 7 lines 27-41, column 7 lines 55-65).

As to claims 5, Nathans teaches these features (column 4 lines 25-55, column 5 lines 57-68, column 7 lines 54-68).

As to claims 6, Nathans teaches these features (column 3 lines 15-25).

For claims 9-13, 15-16, see claims above.

8. Claims 7, 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the double patenting rejection above should also be overcome first.

9. Claim 17 is allowed over the prior art of record. In addition, the double patenting rejection above should also be overcome first.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Bijan Tadayon whose telephone number is (703) 308-7595. The fax number is (703) 308-5397.

Dr. Bijan Tadayon

December 21, 1999

Dr. B. Tadayon

DR. BIJAN TADAYON
PATENT EXAMINER

Primary Examiner